

REMARKS

In the Office Action, claims 1-11, 13-15, and 17-27 were rejected. By the present Response, claims 1, 10, and 15 are amended. Claims 25, 26, and 27 are cancelled. Upon entry of these amendments, claims 1-11, 13-15, and 17-24 will remain pending in the present patent application. In view of the claim amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Preliminary Remarks and Interview Summary

As a preliminary matter, it is noted that in response to the previous Office Action mailed December 31, 2008, Applicants submitted Rule 131 declarations from Yaseen Samara, Vijaykalyan Yeluri, co-inventors of record for the present application, and of the undersigned, Patrick S. Yoder, the attorney who prepared and filed the present application. Another set of Rule 131 declarations from the co-inventors and the undersigned were also previously submitted in response to the Office Action mailed June 20, 2008. Along with these previously submitted declarations, Applicants provided copies of e-mail correspondence as exhibits for demonstrating conception of the invention *prior* to the filing date of the Siegel reference (see discussion below), as well as an affidavit from the undersigned, Patrick S. Yoder, attesting to a case work backlog and to diligence in preparing and filing of the instant application. Based on these previously submitted declarations and evidence, it is believed that Applicants have demonstrated conception of the invention from prior to the filing of Siegel, coupled with diligence up to the filing of the present application (constructive reduction to practice).

In the present Office Action, the Examiner requested “concrete factual evidence” that the attorney has had a reasonable backlog of unrelated cases in order for the examiner to make a determination of reasonable diligence. In order to clarify the issues, a telephonic interview was requested which took place on July 30, 2009. In accordance with 37 C.F.R. §1.133 and M.P.E.P. §713.04, Applicants hereby provide the following summary of a telephonic interview between the Examiner, Brian Q. Le, and Applicants’ attorneys, Patrick S. Yoder and Ricardo Yopez (hereinafter “Applicants’ attorneys”),

conducted on July 30, 2009. In the interview, the issue of the Rule 131 declarations was discussed. The Examiner suggested presenting a third round of evidence to add to the previously presented Rule 131 affidavits and evidence submitted in response to the office actions mailed on June 20, 2008, and December 31, 2008. Specifically, the Examiner suggested submitting a subset of Mr. Yoder's docket entries. The Applicants' attorneys explained that attorney-client confidentiality and ethics rules would preclude a disclosure of such client information, especially client information that could be used in a manner detrimental to Applicants' attorneys' clients. The Applicants' attorneys also explained that current case law grants that attorneys be given a reasonable time to prepare a patent application, and that a preparation time of three months has been found reasonable. The Applicants' attorneys agreed to summarize case law on the issue of reasonable time for preparation and filing of patent applications. This has been done and the law is presented in more detail with respect to the claims rejections under 35 U.S.C §103 discussed below. The interview also focused on the claim rejections under 35 U.S.C §101. While no specific agreement was reached regarding allowability, the Examiner helpfully suggested that the current amendments would likely overcome the outstanding 35 U.S.C §101 rejections.

Claim Rejections Under 35 U.S.C. §101

In the Office Action, the Examiner rejected claims 1-11, 13-15, and 17-18 under 35 U.S.C. §101 as not falling within one of the four statutory categories of invention in view of *In re Bilski*, 54 F.3d 943, 88 U.S.P.Q. 2d 1385 (Fed. Cir. 2008) (*en banc*). The Examiner maintained the rejection of claims 25-27 under 35 U.S.C. §101 as being directed to non-statutory subject matter. With regard to claims 1, 10, and 15, the Examiner stated that claims 1, 10, and 15 disclose a "method/process" which is not tied to another statutory category and thus does not qualify as a statutory process. Other claims were rejected because they are depending on the independent claims 1, 10, and 15. Although Applicants do not necessarily agree that the Examiner's reasoning in rejecting claims 1-11, 13-15, and 17-18 is proper, Applicants have chosen to amend each of independent claims 1, 10, and 15.

Legal Precedent

In determining when process or method claims include statutory subject matter, the Federal Circuit has held that “the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under §101.” *In re Bilski*, 54 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008) (*en banc*). With regard to the machine-or-transformation test, the Federal Circuit explained that “[a] claimed process is surely patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.”

Deficiencies of the Rejection of Independent Claims 1, 10, and 15

Applicants have amended independent claims 1, 10, and 15 to recite “[A] computer-implemented method for processing digital images comprising: on a physical computing processor: ...” Applicants respectfully submit that the additional recitation of a physical computing device clearly ties the method claim to a particular machine or apparatus. Furthermore, the specification is replete with references to medical computing machines and apparatuses for processing digital images.

For at least these reasons, Applicants submit that independent claims 1, 10, and 15 and their dependent claims recite statutory subject matter under 35 U.S.C. §101. Applicants therefore respectfully request the withdrawal of the rejections under 35 U.S.C. §101 and the allowance of claims 1, 10, and 15 as well as those claims depending therefrom.

Claim Rejections Under 35 U.S.C. §103

In the Final Office Action, claims 1-7, 10, 13, 14, 19, 20, 22, 23, 25, and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Siegel et al., U.S. Patent No. 7,149,353 (“Siegel”) in view of Ittner, U.S. Patent No. 5,664,027 (“Ittner”). The Examiner also rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over Siegel in view of Ittner, as applied to claim 1, and further in view of Willis et al., U.S. Patent No. 5,568,571 (“Willis”). The Examiner also rejected

claims 8, 11, 15, 17, 18, 21, 24, and 27 under 35 U.S.C. §103(a) as being unpatentable over Siegel in view of Jordan, U.S. Patent No. 6,823,203 (“Jordan”), and Ittner. Applicants respectfully traverse these rejections.

Prior Invention with Regard to Siegel

To establish prior invention, an applicant must present a “showing of facts [that] shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.” 37 C.F.R. §1.131(b). Applicants respectfully submit that such a showing is made by way of the previously presented declarations and evidence and the currently presented remarks. The previously presented declarations include declarations under 37 C.F.R. §1.131 of Yaseen Samara dated March 30, 2009 (hereinafter the “Samara Declaration”) and of the undersigned, Patrick S. Yoder, dated March 31, 2009 (hereinafter the “Yoder Declaration”), as the attorney who prepared and filed the present application.

Under the present set of facts, the relevant critical period runs from just prior to September 23, 2003 (the filing date of Siegel) to the filing of the present application on November 26, 2003. This is a period of approximately two months and three days. The previously presented declarations and exhibits clearly show conception of the invention prior to September 23, 2003 coupled with diligence up to the filing date of November 26, 2003. In the Office Action, the Examiner requested that “concrete factual evidence” of the attorney’s reasonable backlog be submitted to determine “reasonable diligence”. *See* Office Action, page 2. Furthermore, as mentioned above with respect to the interview summary, the Examiner suggested the submittal of a subset of Mr. Yoder’s docket for a review of reasonable diligence. Applicants respectfully request that the Examiner consider that based on the rules governing attorney-client privilege and ethics, as well as case law that has determined that a period of three months is a reasonable period for the

preparation of a draft patent application, there is sufficient evidence in the record to determine that a showing of reasonable diligence has been made.

The attorney-client privilege has long been recognized as a bedrock of our judicial and administrative system and is codified in part as mandatory Disciplinary Rule 10.57(b) of the Patent and Trademark Office Code of Professional Responsibility. Mandatory Disciplinary Rule 10.57(b) states:

Except when permitted under paragraph (c) of this section, a practitioner shall not knowingly:

- (1) Reveal a confidence or secret of a client.
- (2) Use a confidence or secret of a client to the disadvantage of the client.
- (3) Use a confidence or secret of a client for the advantage of the practitioner or of a third person, unless the client consents after full disclosure.

Furthermore, Rule 10.130 states that an attorney may be suspended or excluded for violating a Disciplinary Rule. *See* Rule 10.130(a). As the Examiner can appreciate, an attorney's docket contains highly confidential client information, including the number of cases worked on, the types of cases worked on, and other similar information. The undersigned has a duty of confidentiality obliging the undersigned to safeguard confidential client information, especially information that may be detrimental to a client. For example, docket information may be data mined for filing patterns, abandonment of applications, etc. Divulging confidential client information would expose an attorney to suspension from practice with the U.S. Patent Office by the Office of Enrollment and Discipline under mandatory Disciplinary Rule 10.57 and Rule 10.130. Similarly, divulging client information may also cause the attorney to lose their law license and be disbarred by the attorney's state Bar Association. Most state Bar Associations, including the Texas State Bar, have rules equivalent to mandatory Disciplinary Rule 10.57 and Rule 10.130 which could be used to disbar an attorney who has breached the attorney-client privilege. *See* Rule 1.05 and 8.04 of the Texas Disciplinary Rules of Professional Conduct. Perhaps more importantly, divulging such information violates the attorney-

client privilege that is a cornerstone of the U.S. Judicial System, to the detriment of any clients whose matters may have required attention during the relevant period.

In determining reasonable diligence, Section 2138.06 of the M.P.E.P. states that attorney diligence is one of reasonable diligence which does not require that “an inventor or his attorney ... drop all other work and concentrate on the particular invention involved....” *Emery v. Ronden*, 188 U.S.P.Q. 264, 268 (Bd. Pat. Inter. 1974). Moreover, Applicants respectfully point out that a period of three months has been found to be a reasonable period for the preparation of a patent application. Specifically, the Court of Customs and Patent Appeals stated that “in many circumstances, one month would be ample allowance to a patent attorney to draft an application; another month could be ample for a draftsman to prepare the drawings; to be generous, perhaps another month could be allowed to have the application placed in final form, executed by the inventor and filed in the PTO. Thus, a three-month period might be excused.” *Shindelar v. Holdeman*, 207 U.S.P.Q. 112, 116. (C.C.P.A. 1980) (Emphasis added). The *Shindelar* holding has been subsequently upheld by the Board of Patent Appeals and Interferences in *Morrison v. Lakes*, Interference No. 104179, (B.P.A.I. 2004), restating that the courts would excuse three months for preparing a patent application. *Id* at 10.

Applicants further submit that diligence was exercised by the inventors and by Mr. Yoder at least from prior to September 23, 2003 and up through the filing of the present application on November 26, 2003, a period of less than three months. As discussed above, prior to September 23, 2003, the subject matter set forth in the 133276 disclosure document was submitted to GE's intellectual property department and received by Fletcher Yoder for preparation of the present patent application. On November 15, 2003, Mr. Yoder sent an e-mail communication containing a first draft of the above-identified application to Messrs. Mathew and Samara for review. *See* Yoder Declaration, paragraph 10; *see also* Samara Declaration, paragraph 9. A set of formal papers, including assignment and declaration forms, were also sent in conjunction with the first draft. *See id.* A redacted copy of this correspondence is provided as Exhibit E of the

Yoder Declaration and as Exhibit D of the Samara Declaration. As indicated in this correspondence, Mr. Yoder requested that the inventors review, provide feedback, and return the executed formal papers by November 24, 2003. *See* Yoder Declaration, paragraph 10; Exhibit E; *see also* Samara Declaration, paragraph 9; Exhibit D. Upon receiving the executed formal papers from each of the inventors, Mr. Yoder filed the above-identified application on November 26, 2003, thereby resulting in constructive reduction to practice of the invention disclosed and claimed in the present patent application. *See* Yoder Declaration, paragraph 11. Thus, a period of less than three months elapsed between the filing of the Siegel application on September 23, 2003 and the filing of the present application on November 26, 2003.

In view of above discussion and the facts provided by the submitted declarations and evidence, Applicants respectfully submit that a showing has been made that the invention disclosed and claimed in the present patent application was conceived prior to September 23, 2003, and that diligent efforts were made from prior to September 23, 2003 to the time the present application was filed (resulting in constructive reduction to practice). Accordingly, Applicants submit that prior invention and due diligence has been demonstrated with respect to Siegel and, therefore, respectfully request that the Examiner remove Siegel as prior art with regard to the present application.

Deficiencies of the Rejection

As noted above, the Examiner rejected all of the pending claims under 35 U.S.C. §103 in the present Office Action relying upon Siegel as a primary reference. Applicants further note that in setting forth these 35 U.S.C. §103 rejections, the Examiner admitted that Siegel fails to disclose several features recited by the pending claims, and thus further relied on one or more of Ittner, Willis, or Jordan as secondary references to cure the deficiencies of Siegel. However, in view of the above discussion, Siegel cannot be considered as prior art with regard to the present application and, therefore, cannot be applied in the instant 35 U.S.C. §103 rejections. Therefore, absent the availability of Siegel as prior art, Applicants submit that Ittner, Willis, or Jordan references, taken alone

or in combination, do not anticipate or render obvious the pending claims. As such, Applicants respectfully request that the Examiner remove Siegel from consideration, withdraw the outstanding 35 U.S.C. §103 rejections, and allow the pending claims.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: August 10, 2009

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